REMARKS

Claims 21-30 are pending in this application. Claims 9 and 12-20 have been withdrawn from consideration, without prejudice to the right of Applicant to pursue the non-elected claims in a divisional application. Claims 21 and 26 have been amended to delete the term "filler-less." No claims have been added or canceled in this Response.

Applicant's representative wishes to thank the Examiner for speaking with him on February 8, 2005 concerning this application. Even though no agreement was reached between the parties, Applicant's representative thanks the Examiner for her helpful comments.

In the November 23, 2004 Office Action, claims 21-30 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention (Office Action at 2). Claims 21-30 were also rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 4,594,475 to Bowman et al. ("Bowman") in view of U.S. Patent No. 6,074,595 to Eisberg et al. ("Eisberg") (Office Action at 3-4).

In view of the following remarks, Applicant respectfully requests reconsideration of the present invention.

Rejection Under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 21-30 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. The Examiner's rejection appears to be based on three terms in Applicant's claims: "cured and filler-less epoxy compound," "sight bowl," and "ultraviolet light absorbers." In light of Applicant's amendments and the arguments that follow, withdrawal of this rejection is respectfully requested.

With regard to "cured and filler-less epoxy compound," the Examiner questions what is intended by the term. Specifically, the Examiner questions whether Applicant means to imply a "cured filler-less structure" or a "cure epoxy structure" (Office Action at 2). Applicant respectfully disagrees with this rejection because the claims would reasonably apprise those skilled in the art as to their scope, once armed with the teachings in the present

specification. Nonetheless, in the interest of advancing prosecution of this application, Applicant has amended independent claims 21 and 26 to delete the term "filler-less." Applicant submit that one of ordinary skill in the art would understand what is claimed by the remaining language (i.e., "cured epoxy compound") when the claims are read in light of the specification. Accordingly, Applicant respectfully submits that the foregoing amendment addresses the rejection based on the use of the term "cured and filler-less epoxy compound" and renders the rejection under 35 U.S.C. § 112 moot.

The Examiner has also objected to Applicant's use of the term "sight bowl." The claims of a patent satisfy the requirements of 35 U.S.C. § 112, second paragraph, where one skilled in the art would understand what is claimed when the claims are read in light of the specification. *See Orthokinetics Inc. v. Safety Travel Chairs, Inc.*, 1 U.S.P.Q.2d 1081, 1088 (Fed. Cir. 1986). A sight bowl is a term that is widely understood in the art and one skilled in the art, reading Applicant's claims in light of the specification, would understand what is claimed. For example, the specification at page 2, lines 2-4 discusses how one embodiment of a sight bowl is used in bushings in utility and industrial transformers to provide a three hundred and sixty degree view of the oil level in the bushing. Embodiments of sight bowls are also discussed in numerous other areas throughout the specification, including at least, page 3, lines 21-29, page 6, lines 4-7 and Figures 1 and 2. Because one skilled in the art would understand what is claimed with regard to "sight bowl," Applicant respectfully requests withdrawal of this rejection.

The Examiner has also objected to the term "ultraviolet light absorbers." As with the term "sight bowl," the term "ultraviolet light absorbers" is a term understood in the art. In addition, Applicant directs the Examiner's attention to at least the following passage from the specification at page 4, lines 12-17:

> It is further preferred that the embodiment also contain ultraviolet light absorbers. When used in the outside environment, for example, the transparent epoxy structure may house light-sensitive materials such as dielectric oil when used in a utility or industrial transformer. As such, the oil can be harmed by continued exposure to ultraviolet rays. Ultraviolet light absorbers remedy this problem when introduced into the epoxy compound at the manufacturing stage.

Based on the knowledge of one skilled in the art, in addition to Applicant's disclosure, one skilled in the art would understand what is claimed when the claims are read in light of the specification. *See Orthokinetics*, 1 U.S.P.Q.2d at 1088.

Based on the foregoing amendments and arguments, Applicant submits that the amended claims comply with 35 U.S.C. § 112, second paragraph. Accordingly, withdrawal of this rejection is respectfully requested

Rejection Under 35 U.S.C. § 103

Claims 21-30 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Bowman (U.S. Patent No. 4,594,475) in view of Eisberg (U.S. Patent No. 6,074,595). Applicant respectfully submits that these references do not, alone or in combination, teach or suggest the invention of claims 21-30 and, therefore, request that this rejection be withdrawn.

Bowman "relates generally to electrical insulating bushings and, more particularly, to such bushings having interchangeable conductors for various current ratings" (col. 1, lines 7-10). As the Office Action acknowledges, Bowman does not disclose a sight bowl "being transparent and comprising a cured and filler-less epoxy compound" (Office Action at 3).

Eisberg is directed to a non-transparent, fiber-reinforced tubular pressure vessel. The Office Action states that Eisberg discloses "a rigid, three-dimensional, transparent structure comprising a cured filler-less epoxy compound having a cylindrical structure." (Office Action at 3). Applicant respectfully disagrees that Eisberg discloses such a structure. The tubular pressure vessel disclosed in Eisberg is **not** transparent or even translucent. For example, Eisberg at column 9, line 14 through column 10, line 31, describes how the structure goes through a filament winding process prior to curing. The resulting product of this process is a **non-transparent**, fiber-reinforced structure - - not a rigid, three-dimensional, transparent structure comprising a cured epoxy compound.

In stating that the structure in Eisberg is transparent, the Office Action points to column 8, lines 44-46 which states that "[b]ecause the polymer material which is used is nonpigmented and therefor highly translucent, bordering upon transparent . . . ." However, the "polymer material" that is described in this section of the patent is **not** the final, fully-cured tubular pressure vessel. Instead, the portion of the specification that the Office Action

points to refers to an *intermediate product* which is *not* fully cured and rigid. For example, the specification states:

> Because of the only **partially cured character of the polymeric material**, such a defect can usually be remedied by carefully slitting the barrier layer with a single-edge razor blade or the like to allow the entrapped air to escape or to remove any impurity and then smoothing the layer so that the interior region of the barrier layer is flush against the polished surface at this point.

(col. 8, lines 52-59, emphasis added). As Eisberg states, the material is partially cured and, in fact, the material is soft enough that the barrier layer can be cut to allow entrapped air to escape before "smoothing the layer" to make it flush. Accordingly, Eisberg does not disclose a "rigid, three-dimensional, transparent structure comprising a cured filler-less epoxy compound" as the Office Action alleges.

The Examiner has also stated that Eisberg discloses a structure containing ultraviolet light absorbers, pointing to column 5, lines 39-50 of the patent (Office Action at 4). The disclosure in Eisberg that the Examiner has pointed to, however, concerns the use of ultraviolet radiation to **cure** the epoxy. There is no disclosure in Eisberg in which the structure **contains ultraviolet light absorbers** which would prevent at least some ultraviolet light from passing through the structure.

Applicant respectfully submits that claims 21-30 are not obvious over the combination of Bowman and Eisberg for a number of reasons. First, even if the teachings of these two references were combined, the invention of claims 21-30 would not be produced. It cannot fairly be said that the cited references, which do not so much as mention or suggest a sight bowl for a bushing of a power transformer where the sight bowl is *transparent and comprises a cured epoxy compound*, render claims 21-30 obvious. As discussed above, Bowman does *not* disclose a sight bowl that is transparent and comprises a cured epoxy compound. Furthermore, Eisberg does not make up for this deficiency since it too does *not* disclose a sight bowl that is transparent and comprises a cured epoxy compound. The wound, fiber-reinforced structure of Eisberg is simply not a transparent sight bowl that comprises a cured epoxy compound as stated in Applicant's claims. Accordingly, the rejection under 35 U.S.C. § 103 is improper. *In re Payne*, 203 U.S.P.Q. 245, 255 (C.C.P.A. 1979) (references

relied upon to support rejection under § 103 must place the claimed invention in the possession of the public).

Even if the references did set out or suggest all of the elements of Applicant's claims 21-30, which they do not, it is still incumbent upon the Examiner, when establishing a *prima facie* case of obviousness under 35 U.S.C. §103, to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicant's disclosure. *See e.g., Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988); *Ex parte Nesbit*, 25 U.S.P.Q.2d 1817, 1819 (Bd. Pat. App. Int. 1992). But, as stated above, "[i]f the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Applicant submits that the Examiner has not established a *prima facie* case of obviousness. See *In re Warner*, 154 U.S.P.Q. 173 (C.C.P.A. 1967).

Simply stated, the Office Action provides no support for the alleged obviousness determination. The requisite motivation is missing from these references, and as stated above, it is improper for the Examiner to rely on Applicant's application to find it. There is no suggestion or motivation to combine Eisberg and Bowman to produce Applicant's invention, and as discussed above, the combination of the two references does not even result in Applicant's claimed invention

Accordingly, the combination of Eisberg and Bowman does not render claims 21-30 obvious. For all of the reasons discussed above, Applicant respectfully requests that the rejection under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

For all the foregoing reasons, Applicant respectfully submits that the instant application is in condition for allowance. A Notice of Allowance is respectfully requested.

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Steven D. Maslowski
Registration No. 46,905

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439